

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : TAN et al.
U.S. Serial No. : 10/578,762
Confirmation No. : 1442
Filed : September 19, 2006
Examiner : Heidi Marie Eide
Art Unit : 3732
For : ORTHODONTIC APPLIANCE

Patent Attorney : Law Offices of Albert Wai-Kit Chan, PLLC
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October 13, 2008

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

**NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES AND PRE-APPEAL BRIEF REQUEST FOR
REVIEW PURSUANT TO PATENT OFFICIAL GAZETTE OF JULY 12, 2005**

This Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences (EXHIBIT A, 1 page) and a Pre-Appeal Brief Request for Review (EXHIBIT B, 1 page) pursuant to program initiated under Patent Official Gazette of July 12, 2005 are being submitted in response to the USPTO Final Office Action dated April 14, 2008.

Applicants authorized payment of ONE HUNDRED AND TWENTY DOLLARS for the fee of one-month extension time on August 14, 2008. Therefore, Applicants hereby petition

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for an additional two-month extension of time and hereby authorize the Commissioner to charge the amount of NINE HUNDRED AND NINETY DOLLARS (\$990.00) to Deposit Account No. 50-1891. This amount is the fee for three-month extension time for large entity minus the one-month extension fee previously paid. This Response is thus considered timely filed by its extended due date of October 14, 2008.

DETAILS OF BRIEF REQUEST

I. CLAIMS UNDER CONSIDERATION

This application enters U.S. national-phase from the PCT and was published as US 2007/0207436 on September 6, 2007 with Claims 1 – 15. Following Applicants' amendments at the International phase lodged with the PCT-IPEA/AU on January 19, 2006, the claims set was reduced to 1 – 13 for consideration and the drawings amended to include, *inter alia*, reference to "first narrowing" (5). In Applicants' response to the Non-Final Office Action dated October 30, 2007 wherein Claims 12 and 13 were objected to as omnibus-type claims, and Claim 11 as having improper multiple dependency, the Applicants cancelled claims 11-13, thus leaving only Claims 1 – 10 for further consideration.

II. ANTICIPATION REJECTION OF CLAIMS 1 – 10

The Examiner's rejection against Applicants' Claims 1 – 10 as being anticipated by Meritt (U.S. Patent No. 5,174,754), in particular Claim 1, hinges on the position of the first narrowing (5) of Applicants' orthodontic appliance relative to the archwire slot (3) and/or base portion (8). Specifically, Claim 1, as it stands at April 14, 2008 upon the issuance of the Final Rejection Office Action, reads as follows in its originally filed version:

1. An orthodontic appliance comprising:
 - a base portion (8) adapted for bonding to a surface of a tooth;
 - a body portion extending from the base portion (8) and having an archwire receiving means and a first narrowing (5) forming a neck portion with said base portion (8) and provided substantially rear of the archwire

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receiving means;

the archwire receiving means having a slot (3) substantially adapted to receive a portion of an archwire (4) and having an opening (9) comprising a second narrowing portion which is narrower than the slot (3).

The Examiner contends that Meritt anticipates this claim by paraphrasing the cited prior art to read along the lines of Applicants' Claim 1, including alleging that its corresponding "first narrowing" 20 forming a neck portion with the base portion 14 is also provided "substantially rear of the archwire receiving means or slot (18).

Responding to the Non-Final Office Action dated October 30, 2007, Applicants submitted that this reading of Meritt is not true and pointed out that Meritt's corresponding first narrowing 20 is provided on about the same plane as the archwire slot and not rear thereof. Applicants presented a few instances of other portions of Meritt's description which corroborate this "same plane" position including

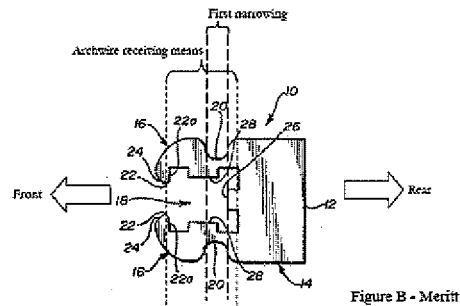
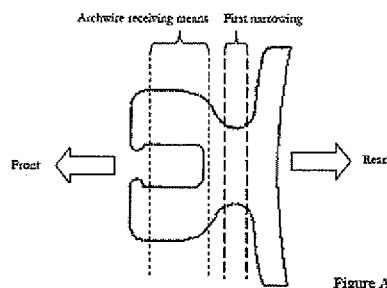
the first narrowing is more accurately described as a "cantilever notch (20)" rather than as a neck-forming first narrowing feature as in Applicants' case; and that

this notch's (20) position is described as "placed on each of the tie wings [col. 2 lines 7 – 8] and cannot therefore be read as rear of the archwire slot.

Unfortunately, the Examiner did not find the above submission persuasive and issued a Final Rejection on April 14, 2008 wherein the position of Meritt's first narrowing as being substantially rear of the archwire receiving means 18 was purported shown in Figure 2 of Meritt's specification. In Applicants' response of August 14, 2008, Applicants provided the following comparative drawings of Applicants' invention and Meritt to reiterate Applicants' views that the prior art's cantilever notches (20) – if they may be taken as equivalents to Applicants neck portion – are clearly on or within the same plane as the archwire slot.

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In addition, the Examiner contends that the word “substantially” in the phrase “...substantially rear of...” is synonymous with “about”, i.e. the neck disclosed by Meritt is at about the rear of the archwire slot. Applicants respectfully disagree and offered more accurate synonyms such as “significantly”, “essentially”, i.e. the neck portion is to be interpreted as significantly or materially rear or posterior to the archwire slot.

III. CONCLUSION

In view of the foregoing remarks, Applicants submit that Claim 1 in particular and Claims 2 – 10 in consequence have been wrongly rejected due to inaccurate reading of Meritt as well as inaccurate reading of Claim 1.

Respectfully Submitted,

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EXHIBIT A

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket Number (Optional)

1189-PCT-US

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____In re Application of
TAM et al.Application Number
10/578,762Filed
September 19, 2006

For ORTHODONTIC APPLIANCE

Art Unit
3732Examiner
Heide Marie EideApplicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ 540.00

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-1891

☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 36,479
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Albert Wai Kit Chan

Signature

Albert Wai-Kit Chan

Typed or printed name

718-799-1000

Telephone number

October 13, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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